



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re PATENT application of:

Applicants: Pierre H.G. Kobben et al.
Application No.: 10/087,613
Filing Date: March 1, 2002
Title: CUSHIONING CONVERSION MACHINE HAVING HEAVY DUTY
CHARACTERISTICS

Attorney Docket: RANPP0310USA

Examiner: Christopher R. Harmon
Art Unit: 3721
Confirmation No. 7942

REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

In response to the Examiner's Answer, mailed April 7, 2004, the undersigned submits this brief in triplicate for the Board's consideration of the appeal regarding the rejection of claims 14-21 of the above-identified application.

A. The Examiner's Answer Failed to Overcome the Deficiencies Identified by the Appeal Brief

In the Reply Brief, the Examiner's responses to Appellants' arguments are not persuasive for the following reasons.

- I. A person of ordinary skill in the art of Kempster¹ would not have considered the teachings of Steffens².*

As cited by the Examiner, "a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned."³ It is well settled in patent law that the references must be considered in their entirety, for their teachings as a whole. The Examiner has not addressed the teachings of the references as a whole, however, in determining whether the references are analogous.

The Examiner responded to Appellants' argument by stating that "Steffens is concerned with positioning rotating roller members for a buckle-type paper folding machine, which is directly applicable to the appellant's field of producing dunnage with a paper web by rotating members."⁴ But both references concern more than their common use of rotating members. Kempster teaches a cushioning conversion machine that coils a narrow central band of a folded and crumpled continuous strip of paper, which has substantial loft outside that narrow band to provide cushioning

¹ U.S. Patent No. 5,873,809.

² U.S. Patent No. 4,032,133.

³ Citing *In re Oetiker*, 977 F.2d 1443, 24 USPQ.2d 1443 (Fed. Cir. 1992), Paper No. 040204, p. 4.

⁴ Paper No. 040204, p. 4.

properties. The strip passes between Kempster's gear wheels, which coin the narrow band. That coined band maintains the shape of the dunnage product as it is handled. Appellants' invention provides an improvement to such a cushioning-producing machine. In contrast, Steffens's card-folding machine does not provide a cushioning product. Steffens's rollers are flatten a folded sheet of paper and crease the folds to make a greeting card or a brochure, for example. When the teachings of these references are considered as a whole, it is clear that Steffens's card-folding machine is neither in Kempster's nor Appellants' field of endeavor.

Steffens's teachings also are not pertinent to the problem with which Appellants were concerned. Appellants addressed a problem with paper stock material jamming in gear wheels, such as those disclosed in Kempster, as the gear wheels attempt to coin the strip of crumpled paper. Steffens does not address this problem. Rather, Steffens addresses problems associated with adjusting a series of more than two rollers while maintaining the spacing of the rollers with respect to one or more fold plates.⁵ Since Kempster only uses one pair of gear wheels, and no teaching or suggestion of maintaining a particular spacing with a fold plate or any other member has been found, a person of ordinary skill would have no reason to consider Steffens.

The Examiner has taken a different approach, concluding that the problem concerns "adjustment" of the gear wheels.⁶ However, the Examiner has not explained why the method of adjusting the pinch pressure between more than two rollers, as disclosed in Steffens, would be sought by the skilled person in the cushioning-producing art of Kempster. The reason such adjustability is important to Steffens is that it is difficult to adjust the spacing between the pairs of rollers in a chain of more than two rollers while keeping the gaps between the rollers aligned with respective fold

⁵ See Steffens, col. 1, line 45 to col. 2, line 20.

⁶ See Paper No. 040204, p. 4.

plates. Kempster does not suffer the same problem, and the skilled person would not have any reason to believe that the solution would benefit Kempster.

Consequently, a person of ordinary skill, seeking to solve a problem of clearing paper jams from the gear wheels of a cushioning-producing machine, such as that taught by Kempster, would not reasonably be expected or motivated to look to ways to adjust a series of more than two rollers for a card-folding machine, as taught by Steffens.

II. Even if the teachings of Steffens were considered alongside those of Kempster, no motivation has been found for combining their teachings.

In the Examiner's Answer, the Examiner has taken the position that "[b]ecause Kempster lacks an express teaching of how the one gear/feed member is adjusted, one of ordinary skill in the art could have looked to Steffens for a teaching of adjustability. . ."⁷ Whether the skilled person could have looked to Steffens is irrelevant to this issue. There must be some reason for doing so, and the Examiner has not identified such a reason.

The Examiner has taken the position that the reason for modifying Kempster's spring-biased gear wheels is that Steffens teaches "'ready adjustment of the spacing between rollers' and biasing to handle 'an unexpected thickness.'"⁸ A spring-biased gear wheel, such as that disclosed in Kempster, presumably can move to accommodate varying thicknesses of crumpled paper. Moreover, no teaching or suggestion has been found that Kempster's biased gear wheels are inadequate for their intended purpose.

⁷ Paper No. 040204, pp. 4-5 (emphasis added).

⁸ Paper No. 040204, p. 5.

The Examiner's statement of the alleged motivation is not a reason for making the proposed combination. Since Kempster already discloses biasing, Steffens's teaching of biasing adds nothing to the teachings of Kempster. Thus the skilled person would not be motivated to make any changes to Kempster's machine to derive the claimed cushioning conversion machine.

III. Even if the teachings of Kempster and Steffens were combined, the claimed invention could not result because neither reference teaches or suggests the claimed locking device.

The Examiner maintains that Steffens's collar 90 is a releasable locking device that holds translating rollers 34 and 48 in a locked position, and that when unlocked, the rollers can pivot away in case of a paper jam.⁹ The Examiner refers to a sentence in Steffens to support this allegation. However, reading the entire paragraph that includes the cited sentence makes it clear that no locking mechanism is present. The rollers move to allow an "unexpected thickness of paper" to pass without jamming.

Furthermore, should an unexpected thickness of paper be presented between stationary roller 20 and translatable roller 34, the translatable roller will be displaced in the direction of arrow A to permit the excessive thickness to pass between the rollers. This arrangement serves the important function of preventing interference between the roller 34 and the leading edge 102 of the fold plate 42. Similarly, a paper jam between rollers 34 and 40 will result in roller 40 being displaced in the direction of arrow B without interference with the leading edge 104 fold plate 44.

Steffens, col. 4, lines 28-38.

⁹ See Paper No. 040204, p. 5.

Additionally, Steffens's pivotable rocker arms 94, 96, 98, 100, to which the rollers 34, 40, 46 and 48 are mounted, are movable between an operative position and an inoperative position, as set forth in the claims. This point was raised in the Appeal Brief but the Examiner did not address it.

Likewise, no teaching or suggestion has been found for a releasable locking device that would allow Steffens's rocker arms to move to an inoperative position when unlocked. While Steffens discloses adjusting collars 90 to adjust the magnitude of the biasing force applied by the resilient sleeves 80 on the rocker arms (Steffens, col. 3, lines 45-52), no teaching or suggestion has been found for adjusting the collars 90 to allow the rocker arms to move to an inoperative position.

For another thing, if Steffens's adjusting collars 90 were loosened as much as possible, "unlocked" in the Examiner's construction, Steffens's adjusting screws 72, 74, 76, 78 would not allow free pivoting of Steffens's rocker arms 94, 96, 98, 100 to such an inoperative position. Pivoting movement of the rocker arms would still be limited by the elongated holes 103 in the rocker arms, the size of the shaft of the adjusting screws 72, 74, 76, 78, the head 84 on the adjusting screw, and the adjusting collar 90 and extension 82 of the frame 83 that supports the adjusting screws. Removing the adjusting screws entirely would allow the rocker arms to pivot freely, but that would be contrary to the teachings of Steffens.

Thus even if the teachings of the applied references were combined, the claimed invention would not result because both Kempster and Steffens fail to teach or suggest the locking device, one which in an unlocked position allows a carrier to be pivoted from its operative position to its inoperative position. Therefore, a person skilled in the art who combines the teachings of Kempster and Steffens could not achieve the machine defined in claim 14.

The same line of reasoning applies to claim 19. Specifically, no teaching or suggestion has been found in the applied references for the claimed mounting assembly for the carrier to which the rotating feed members are mounted. According to

the claims, (a) when the locking device is in its locked condition the carrier can pivot about the frame over a prescribed angular range, and (b) when the locking device is in its released condition the mounting assembly is free to pivot about the frame, carrying the carrier along with it. No such mounting assembly and carrier combination has been found or suggested in Kempster or Steffens or any combination thereof.

Finally, an inherent advantage of the carrier is that it can be pivoted from a locked operative position to clear a jam without adjusting the biasing member. This means that when the carrier is pivoted back to its operative position and locked in place, the operator does not need to adjust the biasing member to adjust the biasing force acting on the gear wheels. No such device is taught or suggested in the applied references, and no structure in Steffens has been found that can provide such an advantage.

For any of these reasons, reversal of the rejection is requested.

B. The Examiner's Rejection of Claim 22 is Improper for Procedural Reasons

Claim 22 was canceled in the response filed on August 4, 2003. In an Advisory Action mailed August 15, 2003, the Examiner indicated that this amendment to the claims would be entered. Consequently, claim 22 is not an issue in this appeal.

C. Conclusion

In view of the foregoing, the undersigned respectfully submits that the claims are patentable over the applied art and that the rejection should be reversed.

Respectfully submitted,
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CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper or item referred to as being attached or enclosed) is being deposited with the U.S. postal service on the date shown below with sufficient postage as first-class mail in an envelope addressed to Mail Stop-Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: June 7, 2004

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